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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,592	03/30/2001	Katayoun Atefi	END9-2000-0117US1	1255
7590 11/29/2007 Hamre, Schumann, Mueller & Larson, P.C. P.O. Box 2902 Minneapolis, MN 55402-0902			EXAMINER LOFTIS, JOHNNA RONEE	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 11/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/822,592	Applicant(s) ATEFI ET AL.	
	Examiner Johnna R. Loftis	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14-18 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14-18 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/16/07 has been entered.

Response to Arguments

2. Applicant's arguments filed 10/16/07 have been fully considered but they are not persuasive. Applicant argues Examiner's reference to *In re Gulack* and *In re Lowry*. Examiner would like to point Applicant to two other informative opinions from the Board of Patent Appeals and Interferences: *Ex Parte Curry* and *Ex Parte Mathias*. Both support Examiner's rejection of claims including non-functional descriptive material. Non-functional descriptive material cannot render nonobvious an invention that otherwise would have been obvious. In the present case, the methodology would be performed the same regardless of the evaluated attributes. The attributes could be different and/or there could be more or less attributes, but in the end the evaluation and completion of an assessment matrix would be carried out in the same fashion. Further, a template is nothing more than a guide. This template could be populated with a plethora of different service attributes and this would not change the end result, an evaluation of the satisfaction of services being provided.

Regarding amendments to the claims, Applicant argues the claimed engagement templates facilitate evaluating the attributes. Examiner construes these templates to be guides for

the evaluator to follow while performing the evaluation. The charts in the SEI Capability Maturity Model references are just that: guides that an evaluator uses to evaluate the service.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 14-18 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over SEI's Capability Maturity Model (CMM) as evidenced by:

“Software Capability Evaluation (SCE), Version 2.0”, hereinafter referenced as SCE
and

Daskalantonakis, Michael K. “Achieving Higher SEI Levels” and implementation of SEI maturity model, hereinafter referenced as Daskalantonakis.

As per **claim 1**, SEI's CMM teaches a template having a set of questions pertaining to an information technology service attribute, the set of questions further comprising a focus area of the service attribute, a set of descriptions of the service attribute, a set of considerations of the service attribute and an example of the service attribute (Daskalantonakis - page 1, pages 2; page 4 shows questions; SCE, page 1-7, maturity questionnaire); a second template comprising an assessment matrix having a plurality of rows and columns, each row corresponding to one information technology service attribute selected from the group consisting of: policies and procedures, team work, consistency of delivery, defect handling, and use of results

(Daskalantonakis - page 2, key areas include approach (=policies and procedures), deployment (=consistency of delivery) and results (=use of results) and page 6 includes intergroup coordination (=teamwork) and defect prevention (=defect handling)), and each column corresponding to a maturity of the information technology service attribute selected from the group of ad hoc, repeatable, consistent, exceptional, and world class (SCE, page 1-4 - initial (=ad hoc), repeatable, defined (=consistent), managed (=exceptional), and optimizing (=world class)), the maturity of each information technology service attribute determined by a customer's answers to its respective set of questions pertaining to the information technology service attribute (Daskalantonakis - page 1, pages 2 and 3 show the matrix; SCE, page 1-4)); and a method to determine if a provider of the information technology service and the customer have a common understanding of the scope and the objectives of the information technology services and to identify any disparity between the expectations of the provider and the expectations of the customer by evaluating the answers to the set of questions and the maturity of the respective information technology service attribute (pages 5 and 6 show compilation of results wherein assessment scores are shown for each key area during the current quarter as well as the previous quarter). SEI's CMM does not expressly teach the specific data recited in the claim, specifically, the claimed attributes; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per **claim 2**, SEI's CMM teaches the technology service attributes comprise the definition and understanding of the information technology service provided by the information technology to the external customer and a focus area of the first engagement template (Daskanlantonakis - page 1, pages 2; page 4 shows questions; SCE, page 1-7, maturity questionnaire), but does not expressly teach the specific data recited in the claim, specifically, the exact set of questions; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per **claims 3-5, 21 and 22**, SEI's CMM teaches templates with descriptions and considerations pertaining to the focus area (approach, deployment and results) and an example pertaining to the focus area (page 2 – focus areas of the key activities along with description/examples). SEI's CMM does not, however, teach the explicit descriptions and examples that are claimed. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per **claim 6**, SEI teaches the template being a matrix further comprising a current maturity level of at least one service attribute and a desired maturity level of the at least one service attribute (Daskalantonakis, page 6, shows goal levels along with current levels).

As per **claim 7**, SEI teaches evaluating the delivery of information technology services to the customer using at least two engagement templates, a first template being a matrix of different levels of maturity of service for a plurality of attributes of information technology services, a second template being a plurality of questions to determine a customer's perception of the level of maturity of the at least one attribute of information technology services (Daskalantonakis - page 1, pages 2; page 4 shows questions; SCE, page 1-7, maturity questionnaire; Daskalantonakis - page 1, pages 2 and 3 show the matrix; SCE, page 1-4); comparing the customer's perception of the at least one attribute of information technology services with the different levels of maturity of the information technology service attribute; and providing a report with recommendations for improving the delivery of the at least one attribute of information technology services to the customer based on the comparison of the customer's perception with the different levels of maturity (pages 5 and 6 show compilation of results wherein assessment scores are shown for each key area during the current quarter as well as the previous quarter; Daskalantonakis, page 6, shows goal levels along with current levels; SCE, page 1-17 - attributes). SEI's CMM does not, however, teach the attributes comprising definition and understanding of the information technology service, the quality of the

information technology service, the marketing and communications of the information technology service, the achievement of results of the information technology service. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.

As per **claim 8**, SEI teaches the second template includes interviewing customers with detailed questions about a plurality of information technology services, the detailed questions having at least one focus area along with a set of descriptions and considerations, and an example for each focus area to determine an in depth assessment of the customer's perception and the current level of maturity of information technology services provided by the information technology organization (SCE, p2-37 – site visit consists of interviews and developing exploratory questions; SCE, page 1-17 – attributes). SEI's CMM does not, however, teach external customers. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per **claim 9**, SEI teaches the first template uses detailed matrices allowing identification of a current level of maturity of at least one service attribute and identification of a desired level of maturity of the at least one service attribute in a workshop approach with customers and the step of providing a report includes comparing the current levels of maturity with the desired level of maturity of information technology services for different aspects of information technology service delivery (Daskalantonakis, page 6, shows goal levels along with current levels; Daskalantonakis - page 1, pages 2; page 4 shows questions; SCE, page 1-7, maturity questionnaire; pages 5 and 6 show compilation of results wherein assessment scores are shown for each key area during the current quarter as well as the previous quarter).

As per claims **14-18**, SEI does not teach the assessment attribute is inventory control, financial reporting, payroll or computer-aided design and manufacturing (see SCE, page 1-17). However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative

difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

As per **claim 23**, SEI does not explicitly teaches the template is a matrix comprising no more than twenty information technology service attributes for a quick, general and/or a medium depth assessment. However it would have been obvious to one of ordinary skill in the art to select no more than twenty attributes for an assessment depending on the situation and as a matter of design choice. The selection of the number of attributes used for assessment will affect the accuracy of the assessment.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bond, US 6,738,736 – method and estimator for providing capacity modeling and planning

Ruffin et al, US 6,249,769 – method, system and program product for evaluating the business requirements of an enterprise for generating business solution deliverables

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Loftis whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

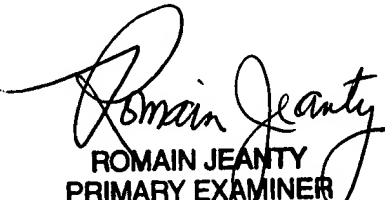
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jl/
11/25/07


ROMAIN JEANTY
PRIMARY EXAMINER
Art Unit 3623